UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/421,434	10/19/1999	TAKAAKI ASADA	36856.00226	4142

7590 06/20/2002

JOSEPH R KEATING ESQ
KEATING & BENNETT, LLP
10400 EATON PLACE, SUITE 312
FAIRFAX, VA 22030

EXAMINER
TUGBANG, ANTHONY D

ART UNIT	PAPER NUMBER
3729	

DATE MAILED: 06/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/421,434	Applicant(s) ASADA, TAKAAKI	
	Examiner Dexter Tugbang	Art Unit 3729	

--The MAILING DATE of this communication appears on th cover sheet with the correspondence addr ss --

THE REPLY FILED 23 May 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires *6* months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on *23 May 2002*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Attachment, Paragraph 1*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Attachment, Paragraph 2*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: *None*.

   Claim(s) objected to: *None*.

   Claim(s) rejected: *1 and 3-20*.

   Claim(s) withdrawn from consideration: *None*.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

PETER VO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

Attachment to Advisory Action

1. Applicant's after final amendment (Paper No. 9) now limits the claims to one, single mechanical latent defect, as opposed to more than one mechanical latent defect. These new limitations require further consideration by the examiner.

2. In regards to the merits of Saitoh, applicant contends that Saitoh does not teach a load impedance circuit and that testing or identifying occurs after manufacturing of the transformer apparatus is completed.

The examiner most respectfully disagrees. The circuit 24 of Saitoh, not only detects impedance, but also through a voltage source carries an electrical load of current. Therefore, the circuit 24 of Saitoh fully satisfies the limitations of a "load impedance".

The examiner's position is that the limitations of "completing the manufacture of the piezoelectric apparatus" is a very broad and relative recitation and that the piezoelectric apparatus of Saitoh is not completed until the apparatus is finally assembled into a medical diagnosing apparatus (at col. 21, lines 35-38). The testing or identification of the mechanical latent defect relied upon in Saitoh (at col. 20, lines 39-59) is performed prior to this completion or assembling of the transformer apparatus into the medical diagnosing apparatus. Thus, Saitoh fully satisfies the specific order (last 5 lines of Claim 1) of identifying and completing.

In regards to the merits of Kawamura, applicant contends that Kawamura does not teach connecting a load impedance to the generator. However, in Figure 5, Kawamura shows a generator read as a voltage source (labeled V), which is connected to an AC current source, i.e. load impedance. Therefore, Kawamura fully satisfies the limitations of "connecting a load impedance to said generator" (line 4 of Claim 1).

In response to applicant's argument that Allen does not teach completing manufacture of the transformer apparatus after the step of identifying or testing, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the step of identifying, i.e. testing, with which the examiner relies upon in Allen, is the determination of the fatal defects prior to packaging (at col. 4, lines 47-50) of the transformer apparatus, not the testing of the already packaged transformer apparatus (at col. 4, lines 28-35) with which the applicant argues. Accordingly, Allen satisfies the order of steps of identifying and completing and is combinable with Kawamura.

In summary above, the examiner maintains the Final Rejection.